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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/340,908 06/28/99 DE LA TORRE R 241/259

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QM12/0912

EXAMINER

THANH, L

ART UNIT

PAPER NUMBER

3763

DATE MAILED:

09/12/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/340,908

Applicant(s)
DeLa Torre et al.

Examiner
LoAn H. Thanh

Group Art Unit
3763



☒ Responsive to communication(s) filed on Jan 19, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-15 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-15 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Claim Objections

1. Claims 12-14 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claims 12-4 are identical to claims 6-8. It is unclear what applicant intended to further limit. It is unclear whether applicant intended claims 12-14 to depend on claim 9. The Examiner is interpreting claims 12-14 to depend on claim 9 for the basis of the art rejection.

Note: Applicant is reminded that claim 14 as it stands is identical to claim 8, however, if applicant were to make it dependent on claim 9, the Examiner would consider it favorable.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 2-5, 9-11, 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claim 2 recites the limitation "said outer surface of said tube " in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 5 recites the limitation "said outer surface of said tube" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 9 recites the limitation "said outer surface of said tube" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 15 recites the limitation "said outer surface of said outer bore" in line 10. There is insufficient antecedent basis for this limitation in the claim. There is support for an inner bore.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1,6-7, 9, 12-13, 15 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Brinkerhoff et al. (U.S. Patent No. 5,366,478) in view of Hunt et al. (U.S. Patent No. 5,273,545) or Ianniruberto et al. (U.S. Patent No. 5,226,890).

See figs. 5-6. Brinkerhoff et al. teach a method of sealing a skin incision for performing an endoscopic surgical procedure at a site in a body. Brinkerhoff et al. teach the steps of providing a

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sealing device such as a trocar having a larger proximal end than the distal end and an inflatable membrane (42) disposed within the inner bore (43, 41), making an incision in the body and inserting and advancing the distal end through the incision to form a seal between the incision and the outer surface (see 5:48-6:8) and inflating the inflatable membrane (42). Specifically, Brinkerhoff et al. teach that "the trocar is naturally sealed at the abdominal wall by the elastic nature of the tissue in the abdominal wall.

If applicant is not convinced that it is deemed inherent by the disclosure, then it would have been obvious to one of ordinary skill in the art to modify the tubular member of Brinkerhoff et al. with the screw threads on the sealing/tubular member of Hunt et al. or Ianniruberto et al. in order to provide better securement of the member to the tissue when the member is manipulated or torqued during the surgical procedure.

6. Claims 2-5,10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brinkerhoff et al. (U.S. Patent No. 5,366,478) in view of Hunt et al. (U.S. Patent No. 5,273,545) or Ianniruberto et al. (U.S. Patent No. 5,226,890).

Brinkerhoff et al. teaches all the limitations of the claims except for the sealing device having fastening means such as screw threads or circumferential ribs or a plurality of protrusions extending from the outer surface of the tube. See above. Hunt et al. disclose fastening means such as screw threads, plurality of protrusions for sealing a body cavity to prevent loss of gas during the procedure in the analogous art of sealing devices. Ianniruberto et al. discloses a conical shaped tissue engager (110) having fastening means such as screw threads in the analogous art of

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sealing devices. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the tubular member of Brinkerhoff et al. for the tubular member having the fastening means of Hunt et al. or Ianniruberto et al. in order to provide better securement of the member to the tissue when the member is manipulated or torqued during the surgical procedure.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1-19 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 7-13 of U.S. Patent No. 5,964,781. Although the conflicting claims are not identical, they are not patentably distinct from each other because they claim broader method steps of using the device.

9. Claims 1-19 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-44 of U.S. Patent No. 5,997,515. Although the

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conflicting claims are not identical, they are not patentably distinct from each other because they claim a device having all the structures which applicant is claiming and the preamble which is directed to the use of the device as a skin sealing device.

Response to Arguments

10. Applicant's arguments with respect to claims 1-14 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

a shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to LoAn H. Thanh whose telephone number is (703) 305-0038.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3590.

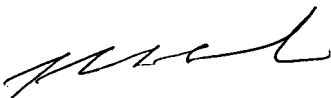
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

LoAn H. Thanh
Patent Examiner



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Date: September 6, 2000



John G. Weiss
Supervisory Patent Examiner
Group 3700